

Appl. No. 09/558,924

REMARKS

Claims 21-22, and 43-49 are pending in the present application. Claim 21 is amended herein. Applicant notes with appreciation the removal of the rejection under 35 USC 101. The remarks below support applicant's assertion that all claims pending in this application are patentably distinct in light of the prior art, and are therefore in condition for allowance.

Claims 21-22 and 43-49 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Wolfe (USP 6,006,252) in view of Ko et al. (USP 6,292,185), in view of Himmel (USP 6,275,854), and in view of Merriman et al. (USP 5,948,061). Applicant has amended claim 21 herein. Support for the amendment adding the limitation "acquired and" to claim 21 (i.e., the frame and content are acquired independently from a web browser) can be found in applicant's specification as filed, for example at page 24, lines 7-24 and elsewhere). Applicant asserts that based on the limitation added by this amendment and/or other limitations found in the claims, claim 21 and the claims dependent therefrom distinguish over the cited references. Furthermore, applicant respectfully traverses the rejection of claim 49, as detailed below.

Attention is directed to applicant's previous responses (e.g., that filed on February 9, 2007) for a brief summary of the presently claimed invention. Applicant asserts that while Wolfe mentions rendering content by an application or the like without employing a web browser to do so, a web browser must be present and operating in order to acquire such content for display. That is, the invention disclosed by Wolfe operates by employing a web browser to request a desired web page. Once retrieved, a system (which particular system depends on the embodiment) determines from the browser request or web page retrieved by the browser whether a supplemental document is available relating to the requested content. If so, an application other than a web browser can be used to display the supplemental document.

Appl. No. 09/558,924

Fundamentally, however, is a requirement that a user employ a web browser to make the initial request for a document. Col. 18, lines 33-36. (N.B., a browser is further required in this embodiment to communicate to the non-browser display application the identity of the documents retrieved. Col. 8, lines 36-38.) In this way, the Wolfe reference does not teach or suggest the limitation of obtaining content independent of the web browser, as claimed at lines 4-5 of claim 21 as amended herein.

Nor does Ko, Himmel or Merriman teach or suggest retrieving content independent of a web browser. The entire thrust of Ko is to obtain special code for customizing a web browser's appearance (col. 3, lines 60-63). Himmel, and Merriman have been discussed by applicant in its previous response. Himmel and Merriman track a user's interaction with objects which must be programmed for, rendered with, and displayed completely within a typical web browser program. For example, Himmel describes a method of tracking the viewing of advertisements (Himmel, col. 8, lines 18-18). Likewise, Merriman tracks the click-through of objects such as banner advertisements "provided to the user's browser." (Merriman, col. 3, lines 53-56.) Thus, in these references, objects are clearly not obtained independently from a Web browser program as claimed in amended claim 21.

It is without question that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). However, none of the references teach or suggest all of the limitations of claim 21. Based on the above, obtaining frame and address content independently from a web browser is one such limitation not shown by the references. As such a limitation is missing from the references when considered alone, it must logically also be missing from the combination of those references. Therefore, applicant asserts that since the cited references taken alone and in combination fail to disclose each limitation of claim 21, that

Appl. No. 09/558,924

claim is not prima facie obvious in light of the combination of Wolfe, Ko, Himmel, and Merriman, and that that claim is patentable over that combination of references.

In addition, claims 22 and 43 through 48 each depend, directly or indirectly, on claim 21, and therefore contain all limitations of claim 21. As the combination of the cited references fails to teach all elements of claim 21 and thus fail to render that claim prima facie obvious, for the same reasons the combination must also fail to teach all elements of claims 22 and 43 through 48, and thus fail to render those claims prima facie obvious. Applicant therefore requests reconsideration and allowance of claims 21-22 and 43-48.

With regard to claim 49, that claim includes the limitation "the information includes instructions for invoking a first computing device resident process executable independent of a Web browser" (claim 49, lines 5-6 and 12-13). That is, the instructions are able to invoke a process without interaction with (i.e., "independent of") a Web browser application. Again, applicant asserts that initiating content access by way of a web browser is a critical step in the identification of content to be rendered by any non-browser application according to Wolfe. It is the browser which provides at least the identity of the document to be displayed by such a non-browser display application. The dependence upon a browser by the processes disclosed by Ko, Himmel, and Merriman have been discussed above.

Accordingly, Wolfe, Ko, Himmel, and Merriman, alone and in combination depend upon a Web browser application for execution. Therefore, such a combination does not disclose or suggest each limitation of claim 49. Accordingly, no prima facie case of obviousness has been made as to claim 49. For this reason, applicant respectfully traverses the rejection of claim 49 in light of Wolfe, Ko, Himmel, and Merriman and respectfully requests reconsideration and allowance of the that claim.

Appl. No. 09/658,924

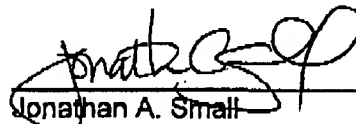
Conclusion

Applicant has addressed the rejection of claims 21-22 and 43-49 under 35 USC §103 on the grounds that not every limitation in those claims is disclosed by the proposed combination of references. Therefore, the present application is thought to be in condition for allowance. Accordingly, favorable reconsideration and issuance of a formal Notice of Allowance for this application in light of the amendments and remarks provided above is respectfully requested.

By action taken here, Applicant in no way intends to or causes any surrender of any subject matter or range of equivalents beyond that strictly required to patentably distinguish the claimed invention as a whole over the prior art. Applicant expressly reserves without dedication all such subject matter and equivalents that may fall in the range between Applicant's literal claim recitations and combinations taught or suggested by the prior art. Furthermore, distinctions between the claims and cited references in addition to those made herein may exist. Thus, applicant also reserves the right to highlight some or all of those additional distinctions at a later date, if appropriate.

If the Examiner believes that a telephone conference would expedite prosecution and allowance of this application, please telephone the undersigned at 650-941-4470.

Respectfully submitted,


Jonathan A. Small
Attorney for Applicant
Registration No. 32,631
Telephone: 650-941-4470

343 Second St., Suite F
Los Altos, California
Date: July 17, 2007